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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/851,864

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Natsume Matsuzaki

NAK1-BO73

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07/15/2005

SNELL & WILMER LLP

1920 MAIN STREET

SUITE 1200

IRVINE, CA 92614-7230

EXAMINER

LIPMAN, JACOB

ART UNIT

PAPER NUMBER

2134

DATE MAILED: 07/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/851,864

Applicant(s)

MATSUZAKI ET AL.

Examiner

Jacob Lipman

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17 and 57-76 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17 and 57-76 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 17 and 57-61, 68, 70-73, and 76 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 17 recites the limitation "a password" in section (a). It is unclear if this is the same password as previously mentioned in the claim.

Claim 17 further recites the limitation "a file key" in section (b). It is unclear if this is the same file key as previously mentioned in the claim.

Claim 68 recites the limitation "encrypts the key information". The claim does not recite how the key information is loaded.

Claims 70-73 claim an encryption unit that seemingly decrypts. It is unclear how the encryption unit is generating the decrypted data.

Claim 76 is unclear and indefinite because the alteration disclosed would make it impossible to complete the steps of the depended upon claim. Claim 62 recites "decrypt the encrypted key in the memory unit. This key would no longer exist in claim 76. It is unclear what modifications to claim 62 would be needed to complete the limitation of claim 76.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 17, 57-58, 60-65, 67-71, 74, and 76, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Schneier, in "Applied Cryptography second edition".

With regard to claim 62 and 17, Schneier discloses a file encryption apparatus (pages 180-182), that encrypts plaintext to generate a cipher text and stores the cipher text into a memory unit (page 180 last paragraph), including storing key information in a key storage medium (page 181 paragraph 2), registration means for receiving a password, which encrypts the key information and writes the encrypted key to memory (page 181 paragraphs 5-6), and an encryption unit which encrypts a plaintext using a file key (page 180 last paragraph), and encrypts the file key using the key information, before writing the encrypted file key to memory (page 181 paragraphs 5-6). Schneier further discloses switching between the key storage medium and password, to obtain the key information (page 182 paragraph 4), which obtains the key from both memory and the portable ROM key in order to decrypt the cipher text.

With regard to claims 57, and 63 Schneier discloses the password is unique to Alice (page 180 last paragraph)

With regard to claims 58, 61, 64, and 65, if the encrypted key or cipher text have been altered, the key will not decrypt the cipher text.

With regard to claims 60, 74, and 76, Schneier discloses the files are used together, and thus are associated to each other (page 181).

With regard to claims 67-71, Schneier discloses updating the key (page 180 section 8.6, pages 183-185).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 59, 66, 72, 73 and 75, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneier.

With regard to claims 59 and 66, Schneier discloses the apparatus of claims 17 and 62, as outlined above, but does not specifically mention the storage medium being portable. The examiner takes official notice that portable computers are common, and well known in the art. It would have been obvious to one of ordinary skill in the art that Schneier's key storing techniques could be used in a portable device in order to secure the stored data. The examiner further points to *In re Lindberg*, 194 F.2d 732, 735, 93 USPQ 23, 26 (CCPA 1952) which states that making a device portable is an obvious modification to one of ordinary skill in the art.

With regard to claims 72, 73, and 75, Schneier discloses the apparatus of claim 69 as disclosed above, but does not specifically mention storing the files as a unified file. The examiner takes official notice that files are stored in directories, which are files

containing multiple files. It would have been obvious to one of ordinary skill in the art to allow the user to place the key and cipher text in the same directory to be organized.

Response to Arguments

7. Applicant's arguments filed 15 April 2005 have been fully considered but they are not persuasive.

Applicant argues that Schneier does not disclose a switching apparatus. The examiner points to page 181 paragraph 4, which discloses using both the stored key and the key from the ROM key. The examiner further points out that the claimed switching unit also reads on backing up keys (Schneier 181-182).

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 2134

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob Lipman whose telephone number is 571-272-3837. The examiner can normally be reached on M-Th 7 AM-3 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on 571-272-3838. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JL

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